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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/849,197	05/20/2004	Takeru Watanabe.	0171-1098PUS1	7290

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EXAMINER

CHU, JOHN S Y

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 09/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/849,197

Applicant(s)

WATANABE ET AL

Examiner

John S. Chu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 6-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This Office action is in response to the election received June 29, 2005.

1. Applicant's election with traverse of the invention elected in the reply filed on June 29, 2005 is acknowledged. The traversal is on the ground(s) that statutory restriction has not been met, classification does not support a restriction, the examiner has carved out a portion of applicants invention, search is not a serious burden, applicant has paid a fee to have all the claims examined, PCT prohibits restriction, restriction is discretionary. All of these reasons are not found persuasive because applicant's representative have argued against the restriction for categorical reasons and have failed to address the specific nature of the claims. The arguments reference PCT which have no relevance or authority to U.S. applications file under 35 U.S.C 111 (a). Applicants again rely on a categorical argument by referring to 35 U.S.C. 121 for divisional application, however the practice of restriction as directly pasted from the MPEP Rule 803 states

803 Restriction - When Proper

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 - § 806.04(i)) or distinct (MPEP § 806.05 - § 806.05(f)).

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

that . Here the rule states that an application may properly be required to be restricted "...if they are able to support separate patents and they are either independent or distinct.(for emphasis)". The argument attacking the reliance on the classification as a reason to support restriction is a misguided argument. The classification system provides further evidence of burden to support a proper restriction based on MPEP 803 and is not a cornerstone of restriction relying solely on the classification system to single out multiple inventions. Applicant has a right to define his invention and if the invention is properly

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restrictable under the statutes, then the examiner has the discretion to require such as restriction and in the current application a requirement is warranted.

In fact applicant have not fully responded properly to the restriction requirement and is due a "Non-responsive" paper, because a specific species of compound (2)-(6) has not been elected for prosecution, in addition no election for either a positive or negative working composition has been made, thus the applicant is non-responsive in two areas.

Despite the non-responsive election, the examiner will accept the election of just Group I, claims 1-5 alone, however he reserves the right to apply the election of species anytime during prosecution if deemed necessary if the prosecution heads in a direction which would warrant such a restriction.

Accordingly, the requirement is still deemed proper and is therefore made FINAL.

2. Claims 14 and 15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on June 29, 2005.

Double Patenting

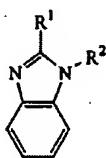
3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

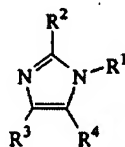
Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 10/679,367, also PGPub. 205/0095527 A1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of current application fully encompass the claims of YOKOYAMA et al for the resist composition having



the basic compound of the formula (1) seen here.

The basic compound in the current application recites the following structure and is fully



encompasses the compound in YOKOYAMA et al., (1) when R³ and R⁴ are defined to be bonded to form a ring.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Failing to particularly define R¹⁴ in formula (7). Correction is necessary.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

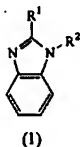
8. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over

YOKOYAMA et al 2005/0095527 A1.

The claimed invention is drawn to the following:

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1. (original) A resist composition comprising at least one basic compound having a benzimidazole skeleton and a polar functional group, represented by the general formula (1):



wherein R¹ is a hydrogen atom, a straight, branched or cyclic alkyl group of 1 to 10 carbon atoms, an aryl group of 6 to 10 carbon atoms, or an aralkyl group of 7 to 10 carbon atoms; and R² is a polar functional group-bearing straight, branched or cyclic alkyl group of 1 to 20 carbon atoms wherein said alkyl group contains as the polar functional group at least one group selected from among ester, acetal and cyano groups, and optionally at least one group selected from among hydroxyl, carbonyl, ether, sulfide and carbonate groups.

YOKOYAMA et al discloses and suggests the claimed compound of formula (1) on page 1, subparagraph [0017] when R⁶ and R⁷ are defined as bonded to form a ring. Here the skilled artisan is clearly motivated to attach a ring to the structure in YOKAYAMA et al as suggested, such as an aromatic ring. Also see claim 1 wherein formula (1) again suggests the use of having a ring structure between R⁶ and R⁷.

It would have been *prima facie* obvious to one of ordinary skill in the art of basic compounds in photoresist compositions to added a ring the compound of formula (1) in YOKOYAMA et al and reasonably expect same or similar results as disclosed in the reference such as high storability and excellent resolution.

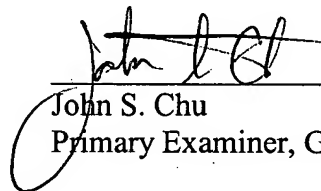
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Chu whose telephone number is (571) 272-1329. The examiner can normally be reached on Monday - Friday from 9:30 am to 6:00 pm.

The fax phone number for the USPTO is (571) 273-8300.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John S. Chu
Primary Examiner, Group 1700

J.Chu
September 18, 2005